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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,619	03/16/2004	Toshihiro Shima	04783.012002	2914

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EXAMINER

SCHLACK, SCOTT A

ART UNIT PAPER NUMBER

2625

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,619

Applicant(s)

SHIMA, TOSHIHIRO

Examiner

Scott Schlack

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/05/06, 06/28/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/17/2006 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims **11** and **12** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims **15** and **18** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More specifically, the examiner notes that the feature of "the control information comprising a number of pages of print data to obtain" is not described in the applicant's

specification. The examiner notes that the disclosed parameters field box containing the text "PAGES = ALL" seen in the browser pages of Figs 5 and 12 do not cover this claimed feature.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **11-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (US 6,791,703) in view of Olbricht (US 6,429,952).

7. With respect to claim **12**, Maeda et al. discloses a printing method, wherein a computer (Client 9 of Fig 1) displays a print acceptance screen (Print Acceptance Screen of Fig 6) based on page data sent from a given node on a network (Network 10A of Fig 6), the print acceptance screen comprising: an area for the user to specify a network printer (Printer Address 503 of Fig 6, col 9, lines 55-59 and col 7, lines 19-20) on the network made to print on the basis of the print data, and to send the acquired print data (Document Location URL 502 of Fig 6 and col 9, lines 55-59 and col 7, lines 13-17) to the network printer (Printer 8 of Fig 1) specified in the area, thereby causing the network printer to print (Print Selection Button 604 of Fig 6).

The examiner views the Print Acceptance Screen to be based on print data (col 1, lines 9-15 and col 2, lines 8-46) and notes that the user is capable of specifying the

network printer desired to print on the basis of the print data (Printer Address 503 of Fig 6, col 9, lines 55-59 and col 7, lines 19-20).

Maeda et al. does not specifically disclose the print acceptance screen comprising: a first area for a user to specify a scanner to acquire print data; a second area for a the user to specify control information for the scanner to use when acquiring the print data , and wherein the computer sends an acquisition/print request to the scanner specified in the first area to cause the scanner to acquire the print data in accordance with the control information specified in the second area.

However the examiner notes that Maeda et al. does disclose the print acceptance screen allowing the user to specify a print data URL on a server where the document is to be acquired (Document Location URL 502 of Fig 6 and col 9, lines 55-59 and col 7, lines 13-17). Further, the examiner notes that the user is capable of specifying control information, through the print acceptance screen, in order to control the printing of the print data (Print Control Screen of Fig 7).

Olbricht does disclose a user interface whereby a user is capable of specifying a scanner to acquire image data through a browser on a computer terminal (Terminal with Browser 12 of Fig 1 and col 3, lines 25-28) as well as a user interface (Fig 2 and col 3, lines 42-65) comprising: an area for the user to specify control information for the scanner to use when acquiring the image data (Fig 2 and col 3, lines 42-65), and wherein the computer sends an acquisition request to the specified scanner to cause the scanner to acquire the image data in accordance with the control information specified (col 1, lines 64-67 and col 2, lines 1-4).

Maeda et al. and Olbricht are analogous art, because they are from the same field of endeavor, namely User Interface Controlled Image Forming Devices.

At the time of the invention, it would have been obvious for one skilled in the art to combine Maeda et al's printing method, wherein a computer displays a print acceptance screen which allows a user to specify a network printer to send and print image data to after first acquiring the data, with Olbricht's scanner control user interfaces allowing a user to both specify an acquisition scanning device along with control information for the scanner to use when acquiring the image data, such that the print acceptance screen or user interface would contain all the scanner, scanner control and print specification capabilities on one page.

The suggestion or motivation for doing so would have been to consolidate the specification information pertaining to both scanning acquisition and printing to one user interface page.

8. With respect to claim **11** the examiner notes identical features to claim 12. Therefore, the explanation given above for claim 12 is also valid for claim 11. The examiner views claim 11 to be encompassed by claim 12.

9. With respect to claim **16**, Maeda et al. in view of Olbricht discloses the printing method of claim 12, wherein the control information comprises resolution of the print data (Olbricht: Resolution Control Information 38 of Fig 2, Maeda et al: Resolution Control Information 32 of Fig 5B and col 9, lines 15-16).

10. With respect to claim **13** the examiner notes identical features to claim 16. Therefore, the explanation given above for claim 16 is also valid for claim 13.

11. With respect to claim **17**, Maeda et al. in view of Olbricht discloses the printing method of claim 12, wherein the control information comprises a mode of the scanner (Olbricht: Mode Control Information 40 of Fig 2).

12. With respect to claim **14** the examiner notes identical features to claim 17.

Therefore, the explanation given above for claim 17 is also valid for claim 14.

13. With respect to claim **18**, Maeda et al. in view of Olbricht discloses the printing method of claim 12, wherein the control information comprises a number of pages of print data to obtain (Maeda et al: Number Of Copies Control Information 530 of Fig 9).

The examiner notes that Maeda discloses a number of pages or copies selection box in the user interface of Fig 9 (Number of Copies Control Information 530) and notes that it would have been obvious to implement a similar selection option in the acquisition step, assuming there are multiple pages being acquired by the scanner.

14. With respect to claim **15** the examiner notes identical features to claim 18.

Therefore, the explanation given above for claim 18 is also valid for claim 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Schlack whose telephone number is 571-272-7954. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Note to the applicant: Art Unit 2624 has been redesignated as Art Unit 2625 due to organizational restructuring with the USPTO.



Scott A. Schlack



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER